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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/477,278

01/04/2000

RAYMOND TAH-SHENG HSU

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06/30/2005

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Patents Department  
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EXAMINER

PHAN, TRI H

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/477,278	Applicant(s) HSU ET AL.	
	Examiner Tri H. Phan	Art Unit 2661	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment/Arguments*

1. This Office Action is in response to the Response/Amendment filed on February 14<sup>th</sup>, 2005. Claims 1-21 are now pending in the application.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-21 of the current Application No. 09/477,278 (hereinafter '278') are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7, 9-13, 15-19, 21-25 of copending Application No. 09/494,199 (hereinafter '199'). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed inventions of the copending Application '199' also disclose about the system and method for informing the packet data services network of dormant network connections associated with the mobile station, when the mobile station moves, e.g. roams, from the first infrastructure element to the second infrastructure element of the packet data services network.

For claim 1 of the claimed invention, the claim 5 of copending application '199' also discloses about the method for optimizing channel resources, when moving from the first infrastructure element to the second infrastructure element of the packet data services network, the mobile station transmits a message including a number of dormant network connections associated with the mobile station and "*enhanced information*" associated with the dormant network connections; wherein, it is obvious that the "*enhanced information*" associated with the dormant network connections can be the "*list of identifiers*" associated with the dormant network connections.

For claim 6 of the claimed invention, the claim 9 of copending application '199' also discloses about the mobile station configuring to inform the packet data services network of dormant network connections associated with the mobile station when the mobile station moves

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from the first infrastructure element of the packet data services network to the second infrastructure element of the packet data services network, the mobile station comprises the antenna, the processor coupled to the antenna and the processor-readable medium accessible by the processor and containing a set of instructions executable by the processor to modulate and transmit from the mobile station a message including a number of dormant network connections associated with the mobile station and a “*reduced list of identifiers*” associated with the dormant network connections when the mobile station moves from the first infrastructure element of the packet data services network to the second infrastructure element; wherein, it is obvious that the “*reduced list of identifiers*” associated with the dormant network connections can be the “*list of identifiers*” associated with the dormant network connections.

For claim 11 of the claimed invention, the claim 15 of copending application ‘199’ also discloses about the mobile station configuring to inform a packet data services network of dormant network connections associated with the mobile station when the mobile station moves from the first infrastructure element of the packet data services network to the second infrastructure element of the packet data services network, the mobile station comprising a device configured to transmit from the mobile station a message including a number of dormant network connections associated with the mobile station and a “*reduced list of identifiers*” associated with the dormant network connections when the mobile station moves from the first infrastructure element of the packet data services network to the second infrastructure element; wherein, it is obvious that the “*reduced list of identifiers*” associated with the dormant network connections can be the “*list of identifiers*” associated with the dormant network connections.

For claims 16 and 21 of the claimed invention, the claim 21 of copending application '199' also discloses about the mobile station configuring to inform the packet data services network of dormant network connections associated with the mobile station when the mobile station moves from the first infrastructure element of the packet data services network to the second infrastructure element of the packet data services network, the mobile station comprises means for transmitting from the mobile station a message including a number of dormant network connections associated with the mobile station and a "*reduced list of identifiers*" associated with the dormant network connections when the mobile station moves from the first infrastructure element of the packet data services network to the second infrastructure element; wherein, it is obvious that the "*reduced list of identifiers*" associated with the dormant network connections can be the "*list of identifiers*" associated with the dormant network connections and wherein the "*means for establishing*" IP instances is obvious in establishing the PPP connection instances between the mobile station and the base station as claimed in the claimed invention 21.

For claims 2, 7, 12 and 17 of the claimed invention, the claims 10, 16 and 22 of copending application '199' also discloses about the dormant network connections comprise "point-to-point protocol connections".

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For claims 3, 8, 13 and 18 of the claimed invention, the claims 8, 17, 23 and 29 of copending application '199' also discloses about the first and second infrastructure elements comprise "packet data service nodes".

For claims 4, 9, 14 and 19 of the claimed invention, the claims 12, 18 and 24 of copending application '199' discloses about the identifiers "are not comprised of" service reference identifiers; wherein, it is obvious that the identifier which "comprises or are not comprised" of service reference identifiers is depend on the system engineering choices.

For claims 5, 10, 15 and 20 of the claimed invention, the claims 13, 19 and 25 of copending application '199' also discloses about the message comprises an original message including an indicator that the dormant network connections are dormant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Manning et al.** (U.S. 6,580,699).

- In regard to claims 1, 11, 16 and 21, **Manning** does disclose in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node 'R-P' ("*Packet Data Services Network*", 'PDSN') connection where the mobile station 'MS' roams from the control of the old base station controller 'BS-O' to the new base station controller 'BS-N' ("*moving from first infrastructure element to the second infrastructure element*"; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point ('PPP') connection with the PDSN (For example see Col. 3, Lines 50-56); the MS stores necessary information such as PPP indicator, session ID, cell ID, etc. ("*list of identifiers*"; For example see col. 5, lines 12-23; col. 4, lines 18-26) and the related R-P connection, e.g. PPP session status ("*active or dormant state*"; wherein "*active state*" is the state where the mobile station is receiving or transmitting data and wherein "*dormant state*" is just the state where the mobile station has nothing, e.g. data, to transmit or receive), and uses the registration message to send information about the PPP session status to the BS-N ("*transmitting the message from the mobile station to the second infrastructure element of the packet data services network*"; For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40; wherein the new BSC receives information about the R-P connection from the mobile station) in order to construct the R-P connection when roaming into a new radio network. **Manning** fails to explicitly disclose about the "*number of network connections*" in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID



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instances (“*IP instances*”) simultaneously (For example see col. 4, lines 18-28) therefore, it is obvious that the MS can send all the necessary information with the appropriated session Ids to the new BS, where the “*number of network connections*”, which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the ‘dormant’ MS has “*dormant connections*” which provide by the PPP session status sent to the BS-N when roaming or idle (For example see Fig. 6; col.5, line 54 through col. 6, line 22).

- Regarding claims 2, 7, 12 and 17, **Manning** further discloses about the ‘dormant’ MS has PPP connections (For example see col. 6, lines 9-13).

- In regard to claims 3, 8, 13 and 18, **Manning** further discloses about the Packet data session nodes (“*first and second infrastructure elements are packet data service nodes*”; For example see Figs. 1-2; col. 3, Lines 32-41).

- Regarding claims 4, 9, 14 and 19, **Manning** further discloses about the R-P indicator, PDSN ID, Pre\_cell ID, session ID (“*the service reference identifiers*”; For example see Figs. 1-2; col. 4, lines 18-26).

- In regard to claim 6, **Manning** discloses in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node ‘R-P’ (“*Packet Data Services Network*”, ‘PDSN’) connection where the mobile

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station 'MS' roams from the control of the old base station controller 'BS-O' to the new base station controller 'BS-N' ("*moving from first infrastructure element to the second infrastructure element*"; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point ('PPP') connection with the PDSN (For example see Col. 3, Lines 50-56); the MS stores necessary information such as PPP indicator, session ID, cell ID, etc. ("*list of identifiers*") and the related R-P connection, e.g. PPP session status ("*active or dormant state*"; wherein "*active state*" is the state where the mobile station is receiving or transmitting data and wherein "*dormant state*" is just the state where the mobile station has nothing, e.g. data, to transmit or receive), and uses the registration message to send information about the PPP session status to the BS-N ("*transmitting the message from the mobile station to the second infrastructure element of the packet data services network*"; For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40; wherein the new BSC receives information about the R-P connection from the mobile station) in order to construct the R-P connection when roaming into a new radio network. It is inherent that the MS has antenna ("*antenna*") for transmitting and receiving call. It is also obvious that the MS has the "*processor*" and memory ("*processor-readable medium*") in order to store necessary information sent to the BS-N or program ("*set of instructions*") in order to perform the modulation for the receiving/transmitting RF signal ("*modulating signal*") or performing methods as disclosed above. **Manning** fails to explicitly disclose about the "*number of network connections*" in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID instances simultaneously (For example see col. 4, lines 18-28); therefore, it is obvious that the MS can send all the necessary information with the appropriated session IDs to the new BS, where the "*number of network connections*",

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which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the 'dormant' MS has "*dormant connections*" which provide by the PPP session status sent to the BS-N when roaming or idle (For example see Fig. 6; col.5, line 54 through col. 6, line 22).

### ***Response to Arguments***

6. Applicant's arguments filed on February 14<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

Applicant argues that **Manning** fails to disclose the limitation "*transmitting from the mobile station to the second infrastructure element of the packet data services network a message including a number of dormant network connections associated with the mobile station and a list of identifiers associated with the dormant network connections.*". Examiner respectfully disagrees.

**Manning** does disclose in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node 'R-P' ("*Packet Data Services Network*", 'PDSN') connection where the mobile station 'MS' roams from the control of the old base station controller 'BS-O' to the new base station controller 'BS-N' ("*moving from first infrastructure element to the second infrastructure element*"; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point ('PPP') connection with the PDSN (For example see Col. 3, Lines 50-56); the MS stores necessary information such as PPP indicator, session ID, cell ID, etc. ("*list of identifiers*"; For example see col. 5, lines 12-23; col. 4, lines 18-26) and the related R-P connection, e.g. PPP session status

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(“*active or dormant state*”; wherein “*active state*” is the state where the mobile station is receiving or transmitting data and wherein “*dormant state*” is just the state where the mobile station has nothing, e.g. data, to transmit or receive or not active) and uses the registration message to send information about the PPP session status to the BS-N (“*transmitting the message from the mobile station to the second infrastructure element of the packet data services network*”; For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40; wherein the new BSC receives information about the R-P connection from the mobile station) in order to construct the R-P connection when roaming into a new radio network. **Manning** fails to explicitly disclose about the “*number of network connections*” in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID instances (“*IP instances*”) simultaneously (For example see col. 4, lines 18-28); therefore, it is obvious that the MS can send all the necessary information with the appropriated session Ids to the new BS, where the “*number of network connections*”, which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the 'dormant' MS has “*dormant connections*” or “*dormant state*”, e.g. the state where the mobile station does not receive or transmit data, but still maintain the PPP connection and the R-P connection (For example see Fig. 6; col.5, line 54 through col. 6, line 22; wherein “*active state*” is the state where the mobile station is receiving or transmitting data and wherein “*dormant state*” is just the state where the mobile station has nothing, e.g. data, to transmit or receive); by providing the PPP session status or necessary stored information to the BS-N, when roaming or idle, for updating or establishing new R-P connection when needed (For example see col.2, lines 19-35) in order to maintain network reliability and efficiency as

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disclosed in col. 4, lines 44-50. Therefore, Examiner concludes that **Manning** teaches the arguable features.

In response to Applicant's argument that the references fail to show certain feature of Applicant's invention, it is noted that the feature upon which Applicant relies (i.e., a “*dormant state*”, which found in the Applicants' specification at page 9, lines 4-14; and wherein the “*dormant state*” and “*dormant connections*” are clearly different from each other, e.g. “*state*” and “*connections*”) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

Claims 2-4,7-9,12-15 and 17-20 are rejected as in Part 5 above of this Office action and by virtue of their dependence from claims 1, 6, 11, 16.

#### ***Reasons For Allowance***

7. Claims 5, 10, 15 and 20 are objected to as being dependent upon a rejected base claim (claims 1, 6, 11 and 16), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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**Lim, Byung Keun** (U.S.6,404,754 and U.S.6,766,168) and **Dynarski et al.**

(U.S.6,628,671) are all cited to show devices and methods for improving the packet data service in the mobile radio telecommunication architectures, which are considered pertinent to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (571) 272-3074. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272-3126.

**Any response to this action should be mailed to:**

**Commissioner of Patents and Trademarks**

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**(571) 273-8300**

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, VA 22314.


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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tri H. Phan  
June 22, 2005

  
**BRIAN NGUYEN**  
**PRIMARY EXAMINER**